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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,116	10/04/2005	Luc Moens	2005_1215A	8632

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WASHINGTON, DC 20006-1021

EXAMINER

LISTVOYB, GREGORY

ART UNIT	PAPER NUMBER
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1711

MAIL DATE	DELIVERY MODE
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09/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/544,116

Applicant(s)

MOENS ET AL.

Examiner

Gregory Listvoyb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

Claims 10-19 rejected under 35 U.S.C. 102(b) as being anticipated by Moens et al (WO 98/18862, cited with equivalent US patent 6635721).

Regarding new Claims 10 Moens discloses an amorphous polyester with acid number within the range of 15-100 mg KOH (see Claim 1) containing 70-100% mol of Isophthalic Acid 0-30% of at least one other aliphatic acid 70-100 mol% of neopentyl diol and 0-30mol% of at least one other aliphatic polyol (Abstract).

In reference to new claims 11-12, Moens teaches that polyester has an, Mn, determined by GPC is within the range of 1100-15500, Tg is 40-80C and melt viscosity 5-15000 Mpa* s (see Claims 1, 10, 12, 13) and hydroxyalkylamide as a crosslinking agent in thermosetting coating composition (see Claim 17).

In reference to new claims 13-14, Moens discloses fumaric, maleic acids and terephthalic acid and 1,4 butanediol, trimethylolpropane (see Column 6, line 5 and line 20).

In reference to new Claim 15, Moens discloses an amorphous polyester containing 70-100% mol of Isophthalic Acid 0-30% of at least one other aliphatic acid

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70-100 mol% of neopentyl diol and 0-30mol% of at least one other aliphatic polyol
(Abstract).

The limitations related to TPA, ethylene glycol and TMP are noted. However, since their content includes 0% (i.e. absence of the component), limitations of Claim 15 are met.

Regarding new Claims 16 and 17, Moens discloses thermosetting composition, having 4-50% wt of crosslinking agent hydroxyalkylamide (see Claims 17 and 19), 55-95%wt of the above amorphous polyester (see Claim 1), light adsorbers, pigments, etc.

Regarding new Claims 18 and 19, Moens discloses a process for coating an article, comprising the steps of:

I) applying to the article by an electrostatic or friction charging gun (see Examples 15-16) on aluminum substrate.

the composition according to claim 16 to form a coating on the article, and

II) heating said coating at a temperature of 200°C.

Double Patenting

Claims 10-19 rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 11, 12, 13 and 17 of prior U.S. Patent No. 6635721. This is a double patenting rejection.

Claims 10-19 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/544336. Although the conflicting claims are not identical, they are not patentably distinct from each other because they related to the same amorphous polyester and .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Regarding the above cited Moen's reference, Applicant's arguments filed on 6/20/2007 have been fully considered but they are not persuasive.

The Applicant argues that "There is no explicit teaching in Moens that use of linear aliphatic C4-C16 diols would be advantageous over other types of polyols."

The Examiner disagrees. Moens uses 0-30% of the above polyols (i.e. 1,4 butanediol) among others (see discussion above), making them equivalent as a part of the polyester.

In reference to the amount of the above diol in the Moen's examples, the Examiner uses the full disclosure of the patent.

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989). See also *Upsher-Smith Labs. v. Pamlab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005) (see MPEP 2123).

Regarding reference of Panandiker et al. (U.S. 5,637,654), Applicant's arguments, see Remarks, filed on 6/20/2007, with respect to simultaneous use of IPA and NPG have been fully considered and are persuasive.

The above reference has been withdrawn.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Listvoyb whose telephone number is (571) 272-6105. The examiner can normally be reached on 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gregory Listvoyb
Examiner
Art Unit 1711

GL



James J. Seidleck
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